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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,789	05/26/2000	Mitchell Reifel	YMEDIA.006A	8494

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EXAMINER

KERR, DEBRA E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 08/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/579,789

Applicant(s)

REIFEL ET AL.

Examiner

Debra E Kerr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 recites the limitation "the encryption" in line 1. There is insufficient antecedent basis for this limitation in the claim. Modifying the claim to read – claim 1 – would have sufficient antecedent basis. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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**Claims 10, 20 and 35-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Zander (US 5,923,906).**

Zander discloses an apparatus for vending a camera to a customer that teaches all the limitations of claims 10 and 35-39. For example, Zander discloses an automated kiosk that dispenses a leased or purchased camera to a customer based on a fee, receives instructions from the customer for photofinishing at return of the camera, and optionally forwards the photographic order to a remote computer for image reproduction and delivery. The type of camera provided to the customer is based on customer information on the intended use of the camera, the desired operating configuration of the camera, and other factors (see at least col. 5 lines 45-65, col. 8 lines 8-61 and col. 22 lines 17-41).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Photographic Trade News, 'Satisfaction Yields Future Gains', July 1994, in view of Segal et al. (US 6,167,251) and further in view of Sheridan (US 5,760,917).**

Photographic Trade News (hereinafter referred to as PTN) discloses a method for specialty camera stores to increase profits by offering photoprocessing promotions to new camera buyers at the time of purchase (see paragraph 9). Please note that although PTN fails to specifically mention determining if a consumer has a financial instrument, doing so is an integral step in any sales process and would have been an obvious determination for a merchant to make as part of a consumer purchasing a camera. Please also note that although PTN fails to specifically mention allowing images of a purchased camera to be displayed on a camera display, it is well known in the digital camera art to provide a display for viewing images, and doing so would have been obvious to one of ordinary skill in the art in order to allow images to be selected for further processing.

PTN fails to teach providing a consumer with a camera in return for a consumer entering into a commitment for purchasing a certain amount of images within a specific time period, or a camera receiving an unlocking code prior to allowing access to encrypted data. Segal discloses a cellular phone system that describes a service provider furnishing electronic devices such as cellular phones to customers at a discount in exchange for the customer's commitment to a long-term service contract which can be based on use of a predetermined number of air minutes. The cellular phone service is secured by encrypted pre-paid airtime communication units with unique identifiers which must be received by the phone unit in order to prevent unauthorized persons from accessing the service and to ensure that the units have been paid for before user access takes place (see at least col. 1, lines 16-58, col. 9 line

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56 – col. 10 line 12 and col. 12 lines 25-44). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine PTN's method of promoting photofinishing services to a camera customer with the teaching of Segal regarding providing discounted electronic devices in exchange for service contracts, in order to provide an ongoing source of revenue to a business and retain customers for selling additional services beyond an initial item purchase.

PTN and Segal fail to disclose encrypting and decrypting an image, or transferring low resolution images from a camera. Sheridan discloses an image distribution method that includes encrypting a digital image and associating specific access rights with the image in order to prevent unauthorized access to the image. The system includes transmitting low-resolution images to third parties under certain conditions where a high-resolution image is not required (see at least col. 3, lines 8-15, col. 5, lines 34-42, col. 7 lines 1-8). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the methods of PTN and Segal with the teaching of Sheridan regarding encrypting an image, in order to ensure that images are accessed by authorized individuals who have previously paid for access to the image, thus ensuring revenues to a business.

Please note that although PTN, Segal and Sheridan are silent regarding receiving image information such as ISO, aperture or shutter speed information in association with an encrypted image, it is notoriously old and well-known to provide information about films and cameras when submitting a film order for photo processing, such as whether the camera is a 135 mm type, and it would have been obvious to one

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of ordinary skill to provide such camera information to aid in better print processing of an order or image reproduction by a photoprocessor and increase customer satisfaction with print products.

**Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over PTN, Segal and Sheridan, and further in view of Bezos (US 6,029,141).**

PTN, Segal and Sheridan substantially disclose the invention but fail to teach receiving an order for an image from someone other than a consumer and crediting the consumer based on the order. Bezos teaches a system of providing compensation to affiliates of a website who refer customers to the website. It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the methods of PTN, Segal and Sheridan with the teaching of Bezos regarding providing a financial reward to someone other than a consumer who refers the consumer and facilitates a sale, in order to increase sales by referring customers to a business from multiple sources who will all benefit from increased revenues.

**Claims 12, 29 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zander (US 5,923,906) in view of Frey et al. (US 6,369,908).**

As per claims 12 and 29, Zander substantially discloses the invention but fails to teach presenting advertising to a user. Frey teaches a photo kiosk with a monitor that displays images taken by a digital camera, and also displays advertisements to the user (see col. 3, lines 31-49, and col. 5, lines 40-43). It would have been obvious to one

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having ordinary skill in the art at the time of the invention to combine Zander's camera vending method with the teaching of Frey regarding displaying advertisements on a camera monitor in order to sell additional products or services and increase sales.

As per claims 42-44, Zander substantially discloses the invention, including leasing a camera to a user, selling a camera to a user and providing prints to a user for a fee (see at least col. 5, lines 46-65). Zander fails to teach providing a user with prints at no additional cost. Frey teaches a photo kiosk that provides a user with temporary use of a camera and a set number of prints for one prepaid fee. It would have been obvious to one having ordinary skill in the art at the time of the invention to combine Zander's camera vending method with the teaching of Frey regarding providing a user with prints at no additional cost in order to simplify the camera leasing process by not requiring a separate transaction for providing prints.

**Claims 11 and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zander in view of Fichtner et al. (US 6,360,362).**

Zander substantially discloses the invention but fails to teach storing camera usage information in camera memory or on a server, modifying camera performance or energy management based on camera usage information, or predicting camera battery life or camera memory based on the number of pictures taken. Fichtner teaches a method of connecting an imaging device such as a camera to a remote host system such as a computer connected to the World Wide Web in order to perform various functions such as modifying the camera's energy management to conserve power,

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configuring the camera's firmware or adding new protocols for accessing the camera's storage medium. A camera may store information internally on defective components, which is then transferred to a remote source for an update. The host application software may request that images are transferred from the camera, including camera setting information such as image pixel, color, compression and orientation information (see at least col. 1 lines 11-53 and col. 7 line 65 – col. 8 line 27). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine Zander's camera vending method with the teaching of Fichtner regarding modifying a camera's performance or energy management in order to automatically upgrade a camera's software or hardware and ensure that the upgrade is performed correctly, thus increasing customer satisfaction with the camera.

Please note that while neither Zander nor Fichtner discloses predicting when camera battery life or memory space will be exhausted based on the number of pictures taken during a predetermined time period, it is notoriously old and well-known in the camera art to display on a camera the number of pictures taken versus the total number of pictures possible, as well as displaying a low battery state existing in the camera. One of ordinary skill in the art would know to predict the camera's condition based on displayed camera indicators generated from, in the case of a digital camera, data stored in the camera's memory.

**Claims 21-28 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zander in view of Enomoto (US 5,974,401).**

Zander substantially discloses the invention, including leasing a camera to a user, and selling a camera to a user, but fails to teach a commitment for a dollar amount or an image amount, receiving user profile information, a time limit on a commitment, fixing a price for an image reproduction, receiving an order for hardcopy image reproductions over a camera user interface or a network, providing additional prints for a fee, or a user designating a print house. Enomoto teaches a digital print order system that receives digital image data fed into a data processing device through an image input device such as a digital camera, along with print option data, delivery timeframe, payment data and user ID data. The user can select which photofinisher will receive the print order, and reject the photofinisher if the delivery date quoted is unacceptable. Customer ID data is captured and additional print orders are expedited by accessing previously stored ID data (see at least col. 2, lines 10-31, col. 3 lines 21-30, col. 4 lines 5-51, col. 5 line 65 – col. 6 line 9). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine Zander's camera vending method with the teaching of Enomoto regarding a digital print ordering service, in order to quickly and conveniently provide prints from digital image data to a customer without requiring a visit to a store.

**Claims 32-34 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zander in view of PTN.**

Zander substantially discloses the claimed invention, including a consumer paying for image reproductions, but fails to teach a camera manufacturer supplying

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cameras to a distributor such as a specialty camera shop which then promotes photoprocessing services to the camera purchasers in order to generate future film processing business. PTN discloses a method for specialty camera stores to increase profits by offering photoprocessing promotions to new camera buyers at the time of purchase (see paragraph 9). Please note that while PTN does not specifically mention a distributor providing a manufacturer a gratuity based on image reproduction sales, it is old and well-known for distributors and manufacturers to contract agreements based on product sales for the purpose of mutual revenue generation. Therefore it would be obvious for a distributor to make such a contract with a manufacturer in order to increase future sales for both parties to the contract and share profits.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra E Kerr whose telephone number is (703) 305-3184. The examiner can normally be reached on 7 a.m. to 4:30 p.m. Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on (703) 305-1440.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is **(703)308-1113**.

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Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks  
Washington D.C. 20231***

or faxed to:

**(703)305-7687** [Official communications; including  
After Final communications labeled  
"Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

Debra E. Kerr

DEK

August 23, 2002

  
GREGORY A. SMITH  
PRIMARY EXAMINER